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PAUL W. MARTIN
NCR CORPORATION, LAW DEPT.
3097 SATELLITE BLVD., 2nd FLOOR
DULUTH, GA 30096

EXAMINER
MONFELDT, SARAH M

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/751,630
Filing Date: December 29, 2000
Appellant(s): WALTER, JOANNE S.

_____
Paul W. Martin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 27 November 2009 appealing from the Office
action mailed August 20, 2007.

*Final Office Action was mailed 20 August 2007;

*Notice of Appeal was filed 22 January 2008;

*Appeal Brief was filed 21 April 2008;

*Examiners Answer was mailed 28 May 2008;

*Supplemental Examiners was mailed on 5 June 2008;

*Order Returning Undocketed Appeal to Examiner mailed 9 January 2009;

*Notification of Non-Compliant Appeal Brief mailed 21 January 2009;

*Petition to revive with Supplemental Appeal Brief filed 27 November 2009;

*Petition Decision: Granted on 1 October 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

1-26

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

Siegel et al.: US Pub. No. 2002/00915262 A1;

Stepanek, Marcia. Protecting E-Privacy: Washington Must Step In". Business Week, New York: July 26, 1999. Iss. 3639; pg. EB30;

PR Newswire. "Love Bug" Virus Raises New Concerns About Password Security. New York: May 12, 2000. (3 pages).

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6, 8-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub No. US 2002/0091562 A1 to Siegel et al. (further referred to as Siegel), and further in view of "Protecting E-Privacy: Washington Must Step In" by Marcia Stepanek (further referred to as Stepanek).

Regarding claims 1 and 21-22, Siegel discloses a method for prescribing personal data preferences (page 1, paragraph 7) comprising the steps of:

a) coupling an electronic consumer device to a computer of a business (page 2, paragraphs 13 and 22-23);

b) accessing a personal data preferences program executed by the computer through use of the electronic consumer device that enables a consumer to create a personal privacy profile choosing, selecting, and then assigning opt in or opt out privacy options to one or more specific, distinct, and different types of personal data collected and maintained by the business for the purpose of identifying and limiting the discrete types of data the business is authorized, by the customer's choice of opt in, to collect, use, and disseminate in accordance with the personal privacy profile data type options selected as opt in by the customer (page 1, paragraph 7; page 2, paragraphs 13 and 23);

c) recording consumer selection of the privacy options via the consumer device by the computer (page 2, paragraphs 13 and 22-23);

d) coding selected privacy options by the computer (page 2, paragraph 24; page 3, paragraph 35);

e) downloading coded privacy options to the consumer device by the computer (page 2, paragraph 24; page 3, paragraphs 33-34; page 4, paragraphs 41-42; page 5, paragraph 44);

f) transferring the coded privacy options to a consumer storage medium separate from the consumer device by the computer (page 2, paragraphs 23-24; page 3, paragraphs 33-34; page 4, paragraphs 41-42; page 5, paragraph 44);

g) reading the coded privacy options from the consumer storage medium by a transaction computer during a transaction between the consumer and the business (page 2, paragraphs 13 and 23-24); and

h) limiting the collection, use, and dissemination of the personal data by the transaction computer in accordance with the coded privacy options (page 1, paragraphs 7 and 12; page 4, paragraph 39; page 5, paragraph 44).

Siegel discloses where the information gathered includes but is not limited to the data types of history of purchases from the business by the consumer, demographic data, amount purchased, frequency of purchase, coupon used, payment method used, time of day, week, and year purchased (page 1, paragraph 12; page 2, paragraphs 14 and 23-24; page 3, paragraph 35; page 4, paragraphs 39-43; page 5, paragraph 44). Siegel does not disclose where consumers may opt out of having this information collected. However, Stepanek discloses where consumers may opt out of having this information collected (pages 1-2). It would be obvious to one of ordinary skill in the art to modify the privacy options for data collection with opt out feature for collection of personal data as disclosed by Siegel to adapt the use of opting out of purchase data collection as disclosed by Stepanek. The motivation would be that purchase information is another form of personal data (as it indicates interests and shopping

patterns, etc.) and users may not want this information collected and stored by a merchant, such as is stated by Stepanek.

Siegel does not disclose where the electronic consumer device is coupled to a computer of a business selling goods or services, where the business selling goods or services provides a personal data preferences program on the coupled computer. However, Stepanek discloses where the consumer is connected to a business offering the personal preferences program (pages 1-2). It would be obvious to one of ordinary skill in the art to adapt the use of maintaining the personal preference program at any phase in the consumer transaction process. Whether the limitation on information gathering is directed to an online advertising business or a business offering products for sale, the limitation on information gathering is stipulated. The motivation of adhering to a customer's wish for limiting data gathering at any point during the transaction by any interested parties would be that the personal preference programming offers the business a way to build customer trust and loyalty and therefore consumers would be more likely to return to this trusted source for future purchasing needs knowing their personal preferences regarding data collection would be honored and respected.

Regarding claim 9, Siegel discloses a method of encoding personal data preferences of a consumer for use during a purchase transaction (page 1, paragraph 7) comprising the steps of:

a) coupling an electronic consumer device to a computer of a business (page 2, paragraphs 13 and 22-23);

b) accessing a personal data preferences program executed by the computer through use of the electronic consumer device that enables a consumer to create a personal privacy profile choosing, selecting, and then assigning opt in or opt out privacy options to one or more specific, distinct, and different types of personal data collected and maintained by the for the purpose of identifying and limiting the discrete types of data the business is authorized, by the customer's choice of opt in, to collect, use, and disseminate in accordance with the personal privacy profile data type options selected as opt in by the customer (page 1 , paragraph 7; page 2, paragraphs 13 and 23);

c) permitting the consumer to select of the privacy options via the consumer device by the computer (page 2, paragraphs 13 and 22-23);

d) encoding selected privacy options by the computer (page 2, paragraph 24; page 3, paragraph 35); and

e) downloading coded privacy options to the consumer device by the computer for later downloading to a consumer storage medium separate from the consumer device (page 2, paragraph 24; page 3, paragraphs 33-34; page 4, paragraphs 41-42; page 5, paragraph 44);

f) reading the coded privacy options from the consumer storage medium by a transaction computer during the purchase transaction (page 2, paragraph 24; page 3, paragraphs 33-34; page 4, paragraphs 41- 42; page 5, paragraph 44) to limit the collection, use, and dissemination of the personal data by the transaction computer in accordance with the encoded selected privacy options (page 1, paragraphs 7 and 12; page 4, paragraph 39; page 5, paragraph 44).

Siegel discloses where the information gathered includes but is not limited to the data types of history of purchases from the business by the consumer, demographic data, amount purchased, frequency of purchase, coupon used, payment method used, time of day, week, and year purchased (page 1, paragraph 12; page 2, paragraphs 14 and 23-24; page 3, paragraph 35; page 4, paragraphs 39-43; page 5, paragraph 44). Siegel does not disclose where consumers may opt out of having this information collected. However, Stepanek discloses where consumers may opt out of having this information collected (pages 1-2). It would be obvious to one of ordinary skill in the art to modify the privacy options for data collection with opt out feature for collection of personal data as disclosed by Siegel to adapt the use of opting out of purchase data collection as disclosed by Stepanek.   The motivation would be that purchase information is another form of personal data (as it indicates interests and shopping patterns, etc.) and users may not want this information collected and stored by a merchant, such as is stated by Stepanek.

Siegel does not disclose where the electronic consumer device is coupled to a computer of a business selling goods or services, where the business selling goods or services provides a personal data preferences program on the coupled computer. However, Stepanek discloses where the consumer is connected to a business offering the personal preferences program (pages 1-2). It would be obvious to one of ordinary skill in the art to adapt the use of maintaining the personal preference program at any phase in the consumer transaction process.   Whether the limitation on information gathering is directed to an online advertising business or a business offering products

for sale, the limitation on information gathering is stipulated. The motivation of adhering

to a customer's wish for limiting data gathering at any point during the transaction by

any interested parties would be that the personal preference programming offers the

business a way to build customer trust and loyalty and therefore consumers would be

more likely to return to this trusted source for future purchasing needs knowing their

personal preferences regarding data collection would be honored and respected.

      Regarding claim 17, Siegel discloses a system for prescribing personal data

preferences (page 1, paragraph 7) comprising:

      A processing unit (page 3, paragraph 26);

      A network interface in communication with the processing unit and operable to be

coupled to a computer of a business via an electronic network (page 2, paragraphs 13

and 22-23; page 3, paragraphs 26-27); and

      Memory in communication with said processing unit and containing a plurality of

instructions which, when executed by the processing unit (page 3, paragraph 26),

enable

      a) an electronic consumer device to connect to the computer to access a

personal data preferences program of the computer via the electronic network (page 2,

paragraphs 13 and 22-23), the personal data preferences program being operable to

enable a consumer to create a personal privacy profile by choosing, selecting, and then

assigning opt in or opt out privacy options to one or more distinct, and different types of

personal data collected and maintained by a business for the purpose of identifying and

limiting the discrete types of data the business is authorized, by the customer's choice

of opt in, to collect, use, and disseminate in accordance with the personal privacy profile

data type options selected as opt in by the customer (page 1, paragraph 7; page 2,

paragraphs 13 and 23);

b) allowing a consumer via the consumer device to select the privacy options

(page 2, paragraphs 13 and 22-23);

c) convert selected privacy options into a personal data model (page 2,

paragraph 24; page 3, paragraph 35);

d) code the personal data model in a format readable by a retail terminal of the

business during a purchase transaction to limit the collection, use, and dissemination of

the personal data by the retail terminal (page 1 , paragraphs 7 and 12; page 2,

paragraphs 13 and 23-24; page 4, paragraph 39; page 5, paragraph 44);

e) transmit a coded personal data model to the consumer device, wherein the

consumer device is operable to transfer a received coded personal data model onto a

personal data preferences storage medium of the consumer which is separate from the

consumer device and which is read by the retail terminal during the purchase

transaction (page 2, paragraph 24; page 3, paragraphs 33-34; page 4, paragraphs 41-

42; page 5, paragraph 44).

Siegel discloses where the information gathered includes but is not limited to the

data types of history of purchases from the business by the consumer, demographic

data, amount purchased, frequency of purchase, coupon used, payment method used,

time of day, week, and year purchased (page 1, paragraph 12; page 2, paragraphs 14

and 23-24; page 3, paragraph 35; page 4, paragraphs 39-43; page 5, paragraph 44). Siegel does not disclose where consumers may opt out of having this information collected. However, Stepanek discloses where consumers may opt out of having this information collected (pages 1-2). It would be obvious to one of ordinary skill in the art to modify the privacy options for data collection with opt out feature for collection of personal data as disclosed by Siegel to adapt the use of opting out of purchase data collection as disclosed by Stepanek. The motivation would be that purchase information is another form of personal data (as it indicates interests and shopping patterns, etc.) and users may not want this information collected and stored by a merchant, such as is stated by Stepanek.

Siegel does not disclose where the electronic consumer device is coupled to a computer of a business selling goods or services, where the business selling goods or services provides a personal data preferences program on the coupled computer. However, Stepanek discloses where the consumer is connected to a business offering the personal preferences program (pages 1-2). It would be obvious to one of ordinary skill in the art to adapt the use of maintaining the personal preference program at any phase in the consumer transaction process. Whether the limitation on information gathering is directed to an online advertising business or a business offering products for sale, the limitation on information gathering is stipulated. The motivation of adhering to a customer's wish for limiting data gathering at any point during the transaction by any interested parties would be that the personal preference programming offers the business a way to build customer trust and loyalty and therefore consumers would be

more likely to return to this trusted source for future purchasing needs knowing their

personal preferences regarding data collection would be honored and respected.

Regarding claims 2-3 and 15-16, Siegel discloses the method wherein step a)

includes coupling the consumer device to the computer via an electronic network and

where the electronic network is the Internet (page 2, paragraphs 13 and 22-23).

Regarding claims 4-6, 13-14 and 19-20, Siegel discloses the method coding the

selected privacy options into a barcode, a magnetic strip readable format and a

magnetic strip on a card (page 2, paragraph 24; page 3, paragraphs 33-34).

Regarding claims 8, 10, 18 and 23-25, Siegel discloses the method wherein the

consumer device is one of a personal computer or a personal digital assistance (page 2,

paragraphs 13 and 22-24; page 3, paragraph 34).

Regarding claim 11, Siegel discloses the method further comprising the steps of:

f) transferring downloaded encoded selected privacy options onto a code storage

device, the code storage device being readable by the transaction computer during a

purchase transaction (page 2, paragraphs 13 and 23-24; page 3, paragraphs 33-34;

page 4, paragraphs 41-42; page 5, paragraph 44);

g) reading the downloaded encoded privacy options from the consumer storage

medium by the transaction computer during the purchase transaction (page 2,

paragraphs 13 and 23-24; page 3, paragraph 33; page 4, paragraphs 40 and 42).

Regarding claim 12, Siegel discloses the method wherein the code storage device comprises one of an access card and a barcode (page 2, paragraph 24; page 3, paragraphs 33-34).

Regarding claim 26, Siegel does not disclose recording privacy preferences of a customer via a self-service terminal of the seller (page 4, paragraph 40).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Siegel and Stepanek as applied to claim 1 above, and further in view of "Love Bug Virus Raises New Concerns About Password Security" by PR Newswire in May 2000 (further referred to as PR Newswire).

Regarding claim 7, neither Siegel nor Stepanek disclose the method of transferring the coded privacy options to a key flock. However, PR Newswire discloses the method of transferring the coded privacy options to a key flock (page 2, lines 29-32). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of personal customer storage devices for storing personal data as disclosed by Siegel in combination with Stepanek to adapt the storing of personal information in a key fob as disclosed by PR Newswire. The motivation would be that a

key fob is one of many forms of personal storage devices and users find the use of key

fobs convenient as they can be stored on a user's key chain for safe keeping.

(10) Response to Argument

The Appellant's arguments have been considered but are not persuasive.

The Siegel and Stepanek references relate to the exchange of customer

personal data during transactions. Siegel discloses that customers prefer to exercise

control on the use of identifying information, limiting private information available to third

parties linking his identify to his purchases (page 1, paragraph 7). Siegel discloses

where the consumer gains the convenience of electronic communication of selected

information while maintaining control over personal information (page 5, paragraph 44).

While Siegel does not disclose the ability to opt-out of data collection, as discussed in

the rejected claims above, Stepanek discloses where a business offers an opt-out policy

for customers, recognizing that some customers do not want personal information

collected and that the goodwill gained from honoring this wish results in customer

loyalty (pages 1-2).

It would be obvious to adapt the use of maintaining the personal preference

program at any phase in the consumer transaction process. Whether the limitation on

information gathering is directed to an online advertising business or a business offering

products for sale, the limitation on information gathering is stipulated. The motivation of

adhering to a customer's wish for limiting data gathering at any point during the

transaction by any interested parties would be that the personal preference

programming offers the business a way to build customer trust and loyalty and therefore

consumers would be more likely to return to this trusted source for future purchasing needs knowing their personal preferences regarding data collection would be honored and respected.

Applicant argues that the "Two methods of limiting customer information are different, because limits are set and enforced by different entities, Siegel with an EIA facilitator and Applicant with a seller of goods." However, examiner again points out that the limitation on information gathering is stipulated and disclosed by Siegel. And additionally the limitation on gathering and opting out of information gathering is stipulated and disclosed by Stepanek.

Applicant argues that neither Siegel nor Stepanek "discloses assigning opt in or opt out privacy options to one or more specific, distinct, and different types of personal data collected and maintained by the business … ". However, as detailed in the rejection above, Siegel discloses where a accessing personal data preferences for the controlling of that data (paragraphs 7, 13, 22-23) and where the information gathered includes but is not limited to the data types of history of purchases, demographic data, amount purchased, frequency of purchase, coupon used, payment method used, time of day, week, and year purchased (paragraphs 12, 14, 23-24, 35, 39-43, 44). While Siegel does not disclose the opting out of having this data collected, Stepanek discloses where consumers can opt out of having personal data collected while conducting a transaction with a seller. As set forth in the rejection above, it would be obvious that if it is known to gather specific and distinct types of data, and it is known for a consumer to

opt out of having data collected, that the specific and distinct types of data which can be collected could be assigned to be opted from being collected.

In response to Applicant's argument that it would not have been obvious to modify the cited prior art reference(s) to create the claimed invention, the Courts have stated that "[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." KSR Int'l Co. v. Teleflex, Inc. 127 S. Ct. 1727, 1740, 92 USPQ2d 1385, 1396 (2007).

In the instant case, the cited prior art references were available in the field at the time of the purported invention. The Applicant merely implemented a predictable variation of these existing methods in establishing his/her own invention. Such predicatability is based upon the fact that each incorporated method performs the same function and provides the same utility as originally intended in their pre-combination state.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Sarah M Monfeldt/
Examiner, Art Unit 3684

Conferees:

Kambiz Abdi /K. A./
Supervisory Patent Examiner, Art Unit 3684

Vincent Millin/vm/
Appeals Conference Specialist